



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,746	04/03/2001	Christopher Goh	10460-011-999	7301

1473 7590 03/13/2003
FISH & NEAVE
1251 AVENUE OF THE AMERICAS
50TH FLOOR
NEW YORK, NY 10020-1105

EXAMINER

LEE, RIP A

ART UNIT	PAPER NUMBER
----------	--------------

1713

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/825,746	GOH ET AL.	
	Examiner	Art Unit	
	Rip A. Lee	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 and 17-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-16 is/are rejected.
- 7) ☒ Claim(s) 10 and 13-15 is/are objected to.
- 8) ☒ Claim(s) 1-44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>g</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action follows a response filed on January 10, 2003. Applicants have elected prosecution of claims 10-16 without traverse.

Claim Objections

1. Claim 10 is objected to because of the following informalities: (i) change "E is selected from" to "E is selected from the group consisting of," (ii) change "alkoxyl" to "alkoxy," (iii) change "aryloxyl" to "aryloxy," (vi) there is no NHR^2 fragment displayed in the structure accompanying the claim, (v) whereas either one of R^1 or R^2 being joined with X in a cyclic fashion is readily envisioned by one skilled in the art, it is not immediately apparent how both R^1 and R^2 are joined together with X to form a ring, as recited, (vi) change "1, 2, 3, 4, 5, 6" to "1 to 6," (vii) change "y may be 1 or 2" to "y is 1 or 2," (viii) change "y may be 1, 2, or 3" to "y is 1, 2, or 3," (ix) in the present set of claims 10-16, there is no indication of what formula (XXVII) might be; a corresponding figure should accompany the claim. Appropriate corrections are required.
2. Claim 13 and 14 are objected to because of the following informalities: structures associated with the Roman numeral designations need to be included in the claim. Appropriate correction is required.
3. Claim 15 is objected to because of the following informalities: It is not clear what is meant by "pure with respect to the metal." Furthermore, a material is pure or it is not. The non-quantifiable term, "substantially pure," is not currently understood. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10-16 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 11-199592 to Matsui *et al.*

Structures illustrated on page 19 of Matsui *et al.* meet the structural features of the ligand sphere about the metal center, as outlined in present claims 10-14. In terms of the purity of the compound indicated in present claim 15, it has been shown that the pure compounds are unpatentable over impure compounds if the utility is the same. *In re Crossley* 72 USPQ 499, *In re Merz* 1938 CD 728. Finally, regarding claim 16, Matsui *et al.* indicate that M is a group 4 metal. This would include the element, Hf.

6. Claims 10-13, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 00/01460 to Murray.

The prior art of Murray teaches complexes described generally in present claims 10-14 (see Murray, claim 1 for comparison). According to the inventor, the metal M includes group 3-13 elements and lanthanides. This includes the metal Hf, as recited in present claim 16. As such, the requirement that M is not Zr, set forth in present claim 13,

is also met. Regarding claim 15, it has been shown that the pure compounds are unpatentable over impure compounds if the utility is the same (*vide supra*).

7. The prior art made of record but not relied upon is considered pertinent to the Applicant's disclosure.


U.S. Patent No. 6,103,657 to Murray

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

ral

March 6, 2003


DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700